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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,561

01/05/2004

Garret F. Geer

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10/23/2006

THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION,
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,561

Applicant(s)

GEER ET AL.

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 15-19 and 21-23 is withdrawn in view of the newly discovered reference(s) to GREGORY, GILBERT, BRANDENBURG, Jr, GRANGE, and ROTTER. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

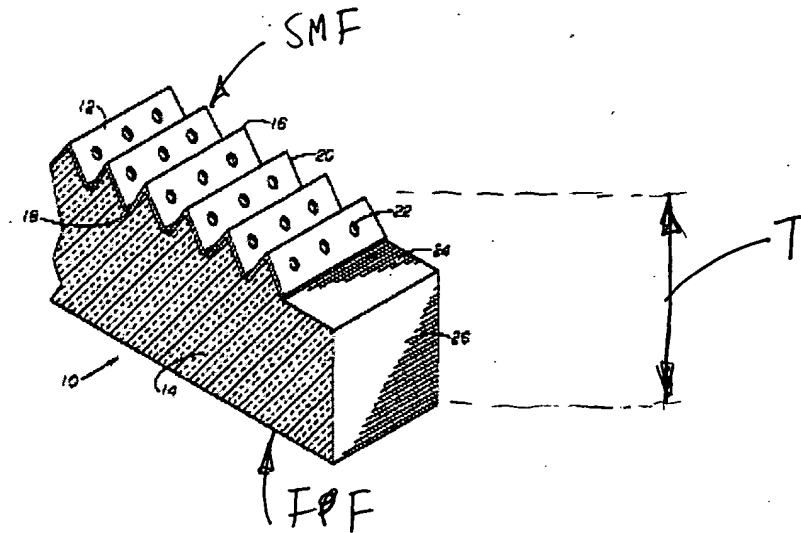
Claims 15-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "the "unitary" attic rafter vent", and the "insulation dam assembly" in line 9. There is insufficient antecedent basis for this limitation in the claim.

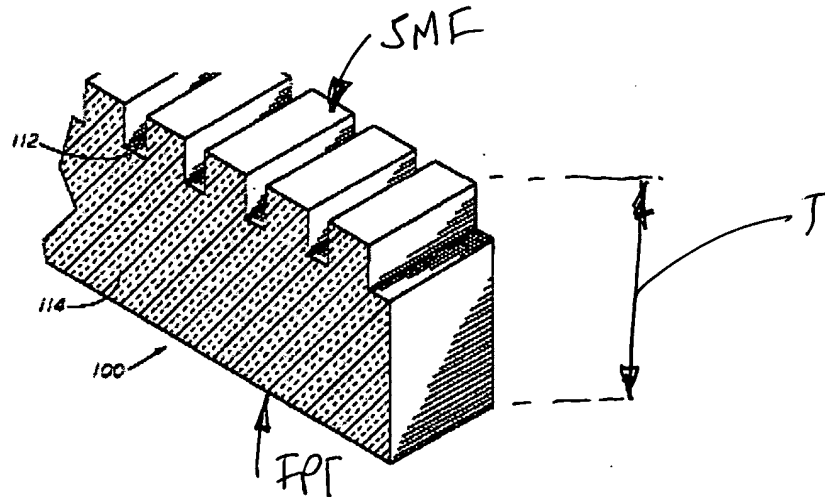
Claim 16 recites the limitation "the "unitary" attic rafter vent", in line 9. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 23, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Clarification and correction are required.



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the basic claimed assembly except for explicitly detailing that his plastic foam insulation material is specifically polyolefin, and except for explicitly detailing a particular thickness and flexibility thereof. Both GEORGEAU et al. and GILBERT teaches the use of a polyolefin foam material (1,14); respectively, (GEORGEAU et al. column 4, line 22 and GILBERT column 3, line 2) for use in a roof structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the insulation material of GREGORY, Jr. et al. out of the polyolefin materials, as taught by either GEORGEAU et al. or GILBERT, in order to ensure that the material is sufficiently flexible for installation while also having a material that is waterproof. For instance a polyolefin material would be more appropriate on sloped roofs as opposed to a flat roof because it is known for its ability to be flexible. Maybe perhaps polyolefin is more sufficient for use in environments that have excessive water exposure as opposed to other materials that deteriorate with over exposure to water. Further, the applicant is reminded that the it too would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material thickness suitable for the use intended as an obvious matter of design choice. In particular, the thinner the

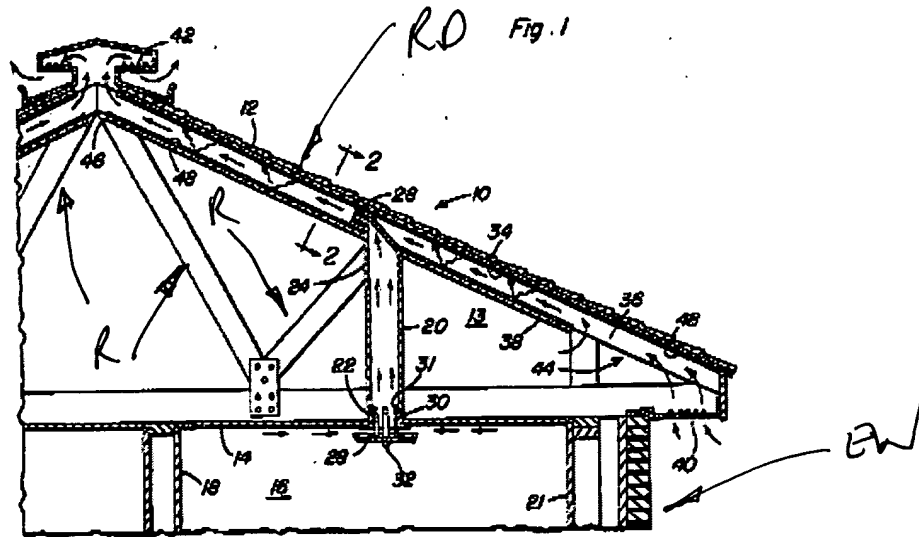
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material, normally the more flexible it is. Thus, if the environment demands a more flexible unit, then perhaps a much thinner member would prove more beneficial. However, on the other hand, if flexibility is not an issue the thickness more than likely would not be as critical. As such, the ability of the member to roll and rebind therefrom also depends on its thickness, another design choice selected according to a specific or desired use. Regarding the thickness of the material, GILBERT expressly details a thickness of 0.01 to 0.5 inches for his insulation material, which is "at least" 0.25 inches. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have an insulation thickness of at least 0.25 inches, as taught by GILBERT, in order to have an insulation batt that is still flexible, able to be corrugated, and still effective in providing insulation to a structure. In reference to claims 2 and 3, the materials of both GEORGEAU et al. and GILBERT are molded extrusions obviously having an olefin homo-polymer. Regarding claim 4, GREGORY, Jr. et al. discloses the use of a polystyrene material, column 2, line 36. In reference to claims 5-7 and 9-11, GREGORY, Jr. et al., as modified by either GEORGEAU et al. or GILBERT, does not disclose the specified insulation thickness or degree of bending of the insulation; however, it too would have been an obvious matter of design choice to select the insulation thickness and degree of insulation to depend upon the use intended as an obvious matter of design choice. Also, the degree of flexibility of the insulation depends somewhat on the extent of select product thickness. Regarding claim 8, in GREGORY, Jr. et al. it is not clear if the insulation thickness (T) is less than or equal to the depth between the rafter and the roof deck; however, it would have been obvious to one

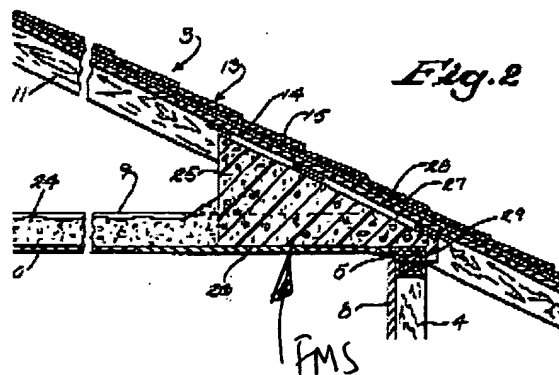
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having ordinary skill in the art at the time the invention was made that the thickness of the insulation be at least less than the depth of the rafters. Otherwise, the roof decking would not rest properly against the rafters. In reference to claims 12 and 13, the second major surface (SMF) includes grooves (G,112) that are extruded/molded, column 2, lines 27-31. Regarding claim 14, GREGORY, Jr. et al. discloses the use of a film/facer (12) attached to the second major face (SMF) of the insulation body (14,114).

Claim 15-26 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,867,956 to GREGORY, Jr. et al. in view of US Patent #3,879,508 to GILBERT as applied to claim 1 above, and further in view of US Patent #4,201,121 to BRANDBEBURG, Jr.; US Patent #3,972,164 to GRANGE and US Patent #5,238,450 to ROTTER. Regarding claims 15 and 16, GREGORY, Jr. et al., as modified by GILBERT, details the structure of the insulation assembly of claim 1 except for explicitly detailing the method of establishing and maintaining air flow between a soffit vent and attic vent. BRANDBEBURG, Jr. teaches the method of establishing and maintaining air flow between a soffit (40) and an attic vent (as at 32) in a building (10) having an exterior wall (EW), a ceiling (14) supported by the wall (EW) and placed against joist/rafters/trusses (R), a roof (12) and roof deck (RD) supported by the wall (EW) and



having a plurality of rafters/rafter trusses (RT) secured to an upper surface of the wall (EW); wherein the soffit (40) is disposed outwardly of the exterior wall (EW) and the attic vent is disposed inwardly of the exterior wall (EW). BRANDENBURG, Jr. does not explicitly detail the use of roof insulation; however, it is old and very well known in the art to provide the roof and attic area of a building with insulation therein. Thus, GRANGE teaches that it is known in the art to orient an attic vent and insulation dam (25) such that a first major face (FMS) faces away from the roof deck (13);



inserting the insulation into a space between adjacent rafters (11), and securing the major face (FMS) thereto. Although GRANGE does not detail bending the insulation, it

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would have been obvious to one having ordinary skill in the art to bend the in order to accommodate junctures. However, ROTTER teaches that it is known in the art to apply a bending force and to bend a insulation sheet (34). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the steps of BRADENBURG, Jr, GRANGE, and ROTTER in order to effectively place an insulation material between rafters to thereby increase the insulative properties of the structure. Allowing the insulation to bend at junction points provides the structure with added resistance to wind, heat, and water infiltration there through. Regarding claim 17, GREGORY, Jr. et al. merely details insulation having grooves on one side.

However, GILBERT teaches that it is known in the art to form grooves on both sides of the material/. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the grooves adjacent the rook deck in order to improve or increase air flow there between. Accordingly, GRANGE also shows this. In reference to claims 18 and 19, the ends of the insulation of GREGORY, Jr. et al., as modified by GILBERT, BRADENBURG et al., and ROTTER, are secured to the rafter by fasteners, adhesives or both. Regarding claims 21 and 22, GREGORY, Jr. et al., as modified by GILBERT, BRADENBURG et al., and ROTTER, does not detail beveling the edge of the insulation; however, it is old and very well known in the art to bevel the edge of an article in order to ease insertion thereof. In reference to claim 23, the first end of the insulation is secured to the ceiling and the second end, adjacent to the rafters.

Allowable Subject Matter

Claims 20 and 24-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 08/10/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a non-perforated film, an insulation dam) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Regarding the applicant's argument that GREGORY does not teach the use of polyolefin, he is correct. GREGORY merely teaches the use of a plastic foam material. GREGORY is provided as a base reference teaching all of the structural details of the claimed invention. However, GEORGEAU et al. and GILBERT are both provided to modify GREGORY by showing the use of polyolefin in corrugated/grooved roof insulating members.

In response to the applicant's argument that GILBERT does not teach placing the insulation atop a roof deck, claims 1-14 are directed to "an assembly" and not a method. As such the requirement of "placing" has no bearing on the issue of

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patentability of the assembly itself. Further, GILBERT clearly details that his device is "for" a roofing insulation assembly, column 4 lines 48-52.

Also, In response to applicant's argument that the device of GILBERT is not "placed" atop a roof deck, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yvonne M. Horton
Examiner
Art Unit 3635

10/16/06